

REMARKS

This Amendment is in response to the Office Action of November 12, 2004. Applicants respectfully submit that all the claims presently on file are in condition for allowance or appeal.

REJECTION UNDER 325 USC 103

Claims 1, 2, 3, 5-13 and 15-17 were rejected under 35 U.S.C. 103 (a) as being unpatentable over He et al. (U. S. Pat. No. 6,088,451), hereinafter referred to as "He" in view of Barrett et al (U.S. 2001/0042051A) , hereinafter referred to as "Barrett". Applicants respectfully traverse this rejection and submit that the claims on file are not obvious in view of cited references. In support of this position, Applicants submit the following arguments:

A. Legal Standards for Obviousness

The following are court opinions set the general standards in support of Applicant's position of non-obviousness, with emphasis added for added clarity:

- MPEP 706.02(j), **"To establish a prima facie case of obviousness, three basic criteria must be met.** First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be

found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) ... The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)."

- In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. The prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure. "Because that insight was contrary to the understandings and expectations of the art, the structure effectuating it would not have been obvious to those skilled in the art." 713 F.2d at 785, 218 USPQ at 700 (citations omitted).
- MPEP §2143.03, "All Claim Limitations Must Be Taught or Suggested: To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."
- MPEP §2143.01, "The Prior Art Must Suggest The Desirability Of The Claimed Invention: There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide

the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

- "**Obviousness cannot be established** by combining the teachings of the prior art to produce the claimed invention, **absent some teaching or suggestion** supporting the combination." *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1598 (citing *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). **What a reference teaches** and whether it teaches toward or **away from the claimed invention** are questions of fact. See *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 960-61, 220 USPQ 592, 599-600 (Fed. Cir. 1983), cert. denied, 469 U.S. 835, 83 L. Ed. 2d 69, 105 S. Ct. 127 (1984). "
- "When a rejection depends on a combination of prior art references, there must be **some teaching, suggestion, or motivation** to combine the references. See *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). "**Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation** to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See MPEP 2143.01; *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).
- "With respect to core factual findings in a determination of patentability, however, the **Board cannot simply reach conclusions based on its own understanding or experience** -- or on its assessment of what would be basic knowledge or common sense. **Rather, the Board must point to some concrete evidence in the record** in support of these findings." See *In re Zurko*, 258 F.3d 1379 (Fed. Cir. 2001).
- "We have noted that **evidence of a suggestion, teaching, or motivation to combine** may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), *Para-Ordinance Mfg. v. SGS Imports Intern., Inc.*, 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," *Rouffet*, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources

available, however, does not diminish the requirement for actual evidence. That is, **the showing must be clear and particular**. See, e.g., C.R. Bard, 157 F.3d at 1352, 48 USPQ2d at 1232. **Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence."** E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977). See In re Dembiczak, 175 F. 3d 994 (Fed. Cir. 1999).

- "To prevent the use of hindsight based on the invention to defeat patentability of the invention, **this court requires the examiner to show a motivation to combine the references** that create the case of obviousness. In other words, **the examiner must show reasons** that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references **for combination in the manner claimed**." See In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998).
- The mere fact that references can be combined or modified does not render the resultant combination obvious **unless the prior art also suggests the desirability of the combination**. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, **there must be a suggestion or motivation in the reference** to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).
- If the **proposed modification would render the prior art invention being modified unsatisfactory** for its intended purpose, **then there is no suggestion or motivation** to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

B. Summary of the Present Invention

Prior to discussing the merit of the obviousness rejection under 35 U.S.C. 103, it might be desirable to review a summary of the present invention and some of the features provided thereby. The present system (or method) introduces the concept of "implicit logoff", which is a secure log-off procedure that can be used in addition to the conventional express log-off and cookie termination.

The implicit log-off procedure presents numerous advantages over the conventional termination or logoff procedures, in that it reduces the risk to a user resulting from choosing an insecure site while logged onto a secure site. Users are provided with pop up warnings on their monitors, alerting them to the unattended pending connection to the secure site. The implicit log-off procedure further mitigates the risk of losing control of private information as the result of a session that has not been appropriately terminated by the user. In addition, the implicit log-off procedure reduces the business costs associated with a non-productive, secure session, and avoids undesirable log-offs by providing to the user appropriate warnings.

The implicit log-off procedure provides an add-on notification module to the user's browser that is completely transparent to the user, sends a message to the ebusiness server notifying it that the client is no longer actively involved in a secure, online transaction. This notification may result from total inactivity on the part of the client, from the client's choice of another site or page that is not secure, or from simply leaving the secure site.

In the event that the user enters another web site while still logged into the secure site, and in particular one associated with an e-business other than the one supporting the secure transaction, a warning message may be displayed on the user's monitor. The warning informs the user that he or she may be in danger of compromising secure information and is advised to log-off from the secure site. Failure by the user to respond appropriately to the warning messages results in an implicit log-off at step 330, which means that the client will implicitly send the log-off message event to the server 15 without the user explicitly choosing the logout option.

In use, the user visits a website of a business using a web browser. At some point, the user enters a secure region through log-in. At this point, the browser begins to track the user's activity. Subsequently, one of the following events may occur:

- a) The user selects a new URL. If this URL is a secure region within the same business site, the warning system remains dormant pursuant to the e-business site administrator policy or discretion.
- b) The user selects a new URL. If this URL is outside the business space, such as for example the URL of another business, the system may be configured to bring up a warning pop-up window on the user's monitor, informing the user that he or she is leaving the security zone. The user is given the opportunity to log off from the secure connection.
- c) The user selects a non-secure region of the same business site. The system may optionally warn the user. Repeated warnings to the user

can cause annoyance and, hence, the system allows the user to turn off these warnings.

- d) The user may enter a period of inactivity within the secure site. After a preset duration the warning system brings up a pop-up window to warn the user that he or she should continue the transaction, log off, or set the time out duration to a period of his or her own choice. Should the client fail to respond in a pre-determined time the system may log off the user.

C. Independent Claims 1, 9, and 11

The following Table summarizes Applicants arguments in response to the office action, in support of the allowability of the representative independent claim 1.

CLAIM 1	OFFICE ACTION REJECTION GROUNDS	ARGUMENTS
1. A system for assisting a user conducting a transaction on a secure site of a server to <u>implicitly logoff from the secure site</u> , comprising: the server including:	As per claims 1, 2, 3, 5-13 and 15-17 He discloses a system/method for securing access to network elements by user elements, wherein the network elements and the user elements are coupled to a network. A network security server ... comprising: the server including:	(1) He does not disclose an implicit logoff process.
a secure transaction protection module that tracks a user's access state to the server;	a secure transaction protection module that tracks a user's access state to the server (see., abstract, lines 7-13, fig 2, please note that user credentials or privileges also include Web site);	
a database in communication with the secure transaction protection module, for storing data to be accessed by the user;	a database in communication with the secure transaction protection module, for storing data to be accessed by the user (see., abstract, lines 14-16, col 2, lines 12-34);	
an identification module for validating the user's access to the database; and	an identification module for validating the user's access to the database (see., abstract, line 7-13, col 2, lines 12-34); and	
a notification module for notifying the secure transaction protection module of a user's request to initiate a session on the server;	a notification module for notifying the secure transaction protection module of a user's request to initiate a session on the server (see., col 31, lines 3038).	

<p>wherein if the user <u>selects</u> an <u>insecure site while</u> <u>logged on to the secure site</u> of the server, the notification module sends a <u>warning notice to the user</u> to alert the user of an <u>impending logoff from the secure site, and further sends a termination command to the secure transaction protection module for implicitly logging off the user from the secure site; and</u> wherein the secure transaction protection module <u>causes the session to be terminated</u> in response to the termination command, <u>absent an instruction from the user to maintain a connection with the secure site.</u></p>	<p><u>It is to be noted that He does not explicitly disclose wherein if the user selects site while logged on to the secure site of the server, the notification module sends a warning notice to the user to alert the user of an impending logoff from the secure site, and further sends a termination command to the secure transaction protection module for implicitly logging off (implicit logging off or leaving the secure site) the user from the secure site, and wherein response to the termination command, absent an instruction from the user to maintain a connection with the secure site exists the secure site, the notification module sends a message to the secure transaction protection module for logging off the user from the secure site.</u></p> <p>However, Barrett discloses web browsers that require that a security warning be displayed to the user which indicates that the user is leaving a secured communication channel (see., <u>page 5, col 1, lines 21-48</u>).</p> <p>Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to <u>modify the security system of He by including the limitations detailed above as taught by Barrett</u> because such modification would provide the security system of He with the enhanced capability of notifying when a user exists the central controller or (secure site).</p>	<p>(2) Neither He nor Barrett provides for an "implicit logoff" process as claimed.</p> <p>(3) Neither He nor Barrett provides the ability to allow the "implicitly log off" process to <u>terminate the connection absent a user instruction to the contrary.</u></p> <p>(4) He and Barrett cannot be properly combined.</p>
--	---	---

First Distinguishing Argument

Applicants are in agreement with the Examiner that He does not expressly disclose the implicit logoff process. Applicants have provided a specific definition of the concept of "implicit logoff" to include a secure log-off procedure **that can be used in addition to** the conventional express log-off and cookie termination.

More specifically, the term "implicit log-off" was coined in the present application for the purpose of describing the functionality of the invention, as follows: "implicit log-off (at step 330, which) means that the client will implicitly send the log-off message event to the server 15 **without the user explicitly choosing the logout option.**"

Since the term "implicit log-off" was clearly defined by Applicants, it would not be permissible for the Examiner to redefine this term in hind-sight, in order to justify a rejection ground. As an example, the fact that the user has left the initial site and the central controller is notified, does not imply that the user will be automatically and implicitly logged off, as described in the present application.

Second Distinguishing Argument

Applicants agree with the Examiner that He does not explicitly disclose:
(1) wherein if the user selects an insecure site while logged on to the secure site of the server, the notification module sends a warning notice to the user to alert the user of an impending logoff from the secure site, and

(2) further sends a termination command to the secure transaction protection module for implicitly logging off the user from the secure site, and

(3) where in response to the termination command, absent an instruction from the user to maintain a connection with the secure site exists the secure site, the notification module sends a message to the secure transaction protection module for logging off the user from the secure site.

In essence, the Examiner is basically arguing that the main reference, namely He, does not disclose the foregoing important elements of the present invention. Rather, the Examiner resorts to a secondary reference, Barrett, to compensate for the absence of these elements from He.

Third Distinguishing Argument

The Examiner states that Barrett discloses web browsers that require that a security warning be displayed to the user which indicates that the user is leaving a secured communication channel, and refers to page 5, col 1, lines 21-48 (Paragraph 47) of Barrett. However, Paragraph 47 states in part, as follows, with emphasis added:

"The user cannot actually leave the secured communication channel until clicking the "continue" button on the security warning.

This extra step imposes an additional burden on the consumer and slows down the processing of the transaction."

In other terms, contrary to the present invention, the Barrett system does not automatically leaves the secure site until expressly authorized by the

user. This feature, which is relied upon by the Examiner, actually teaches away from the present invention that teaches "implicit logoff" to terminate the connection.

Fourth Distinguishing Argument

The Examiner resorts to Barrett as disclosing a security warning. **However, the Examiner does not address the following remaining features**, which, admittedly (by the Examiner) are not disclosed by the primary reference, He:

"the notification module sends a warning notice to the user to alert the user of an impending logoff from the secure site, **and further sends a termination command** to the secure transaction protection module for implicitly logging off the user from the secure site; and wherein the secure transaction protection module **causes the session to be terminated** in response to the termination command, absent an instruction from the user to maintain a connection with the secure site."

Applicants respectfully submit that the foregoing two claim elements are neither disclosed by He nor by Barrett. Accordingly, and pursuant to MPEP 706.02(j) that states: "To establish a prima facie case of obviousness, three basic criteria must be met ... the prior art reference (or references when combined) must teach or suggest all the claim limitations," since **neither He nor Barrett discloses all the elements/limitations of claim 1, the office action fails to establish a prima facie case of obviousness.**

Fifth Distinguishing Argument

Applicants submit that He and Barrett cannot be properly combined in view of the legal grounds above. Neither nor Barrett provides evidence of a suggestion, teaching, or motivation to combine these two references. The legal authorities above require that the evidence be clear and particular, and note that broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence."

More specifically, the fact that it would be desirable to combine "two" references, neither of which teaches the important elements of the invention as claimed, simply to "provide the security system of He with the enhanced capability of notifying when a user exists the central controller or (secure site)" does not qualify as "evidence" within the ambit of the legal authorities above. Actually, it should be clear that the present invention relates to "implicit logoff, and none of these two references provides the ability to allow the "implicitly log off" process to terminate the connection absent a user instruction to the contrary. In addition, and as indicated earlier, Barrett teaches away from the implicit logoff concept and thus clearly distinguishes over claim 1 of the present invention.

Claim 1 is thus not obvious in view of He or Barrett, and the allowance of this claim and the claims dependent thereon is earnestly solicited.

Independent claims 9 and 11 are allowable for containing a similar subject matter to that of claim 1. Therefore, claims 9 and 11 and the claims dependent thereon are also allowable.

CONCLUSION

All the claims presently on file in the present application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned at the below-listed telephone number.

Respectfully submitted,

Date: January 26, 2005

Samuel A. Kassatly Law Office
20690 View Oaks Way
San Jose, CA 95120
Tel: (408) 323-5111
Fax: (408) 521-0111



Samuel A. Kassatly
Attorney for Applicants
Reg. No. 32,247